



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

07/838,598 02/19/92

ROBERTS-LEWIS

J

02655/003002

TRAVERS, R

PAUL T. CLARK  
FISH & RICHARDSON  
225 FRANKLIN STREET  
BOSTON, MA 02110-2804

1205

PAPER NUMBER 1

09/11/92

3

This is a notice of action in a patent application. It is not a notice of allowance. It is not a notice of abandonment. It is not a notice of withdrawal. It is not a notice of restriction. It is not a notice of election. It is not a notice of other.

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.  
Of the above, claims 17-22 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-16 + 23-28 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11: 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

Serial No. 07/838598

-2-

Art Unit 1205

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-16 and 23-28, drawn to compositions inhibiting neural cell death and method of using said compositions.

II. Claims 18-22, drawn to a combination of the active ingredients of group I and Calcium channel blockers to prevent neural cell death.

III. Claims 18-22, drawn to a combination of the active ingredients of group I and compounds effective in blocking the binding sites of neurologically active amino acid analogues to prevent neural cell death.

During a telephone conversation with Paul T. Clark on August 5, 1991 a provisional election was made with traverse to prosecute the invention of group I, claims 1-16 and 23-28. Affirmation of this election must be made by applicant in responding to this Office action. Claims 17-22 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

Claims 1-16 are rejected under 35 U.S.C. § 101 because the invention as disclosed is inoperative and therefore lacks

Serial No. 07/838598

-3-

Art Unit 1205

utility.

The claims set forth numerous conditions treatable with the instant compositions, but fails to show such treatments as effective against the maladies set forth in the instant claims.

*OK  
argued  
cause  
Effect*

Claims 1 and 6-16 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to treatment of various necrotic conditions. See M.P.E.P. §§ 706.03(n) and 706.03(z).

*OK*

Claims 1-16 and 23-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16 and 23-28 are rendered indefinite for failing to indicate if the methods are intended to treat or prevent the enumerated conditions.

*OK*

Claims 2 and 5 are rendered indefinite for failing to specifically set forth the conditions and/or maladies treated. Claims 2 and 5 are directed to the treatment of "calcium related disorder", "motor neuron diseases", Peripheral nerve degradation, or head or spinal cord injuries" and as such fail to specifically set forth the embodiments of the instant claims.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section

Serial No. 07/838598

-4-

Art Unit 1205

102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-16 and 23-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Rosner et al, Jun et al and Larson et al in view of Molnor et al and Effland et al, all of record.

Rosner et al teach the beneficial activity of the claim designated compounds in preventing and treating ischemic damage. Jun et al teach the reduction of oxygen consumption in damaged neurological tissue treated with the claim designated active ingredients. Larson et al teach the claim designated active ingredients capacity to protect against damage due to ischemic neurological disorders. The skilled artisan would have been motivated to employ the instant anti-ischemic compounds for the neural conditions herein claimed. it would follow therefore that the subject matter herein claimed would have been obvious to the skilled artisan and is properly rejected under 35 USC 103.

Applicant has not argued that the claimed proportioning and/or dosage amounts add patentable moment to the recited claims.

Serial No. 07/838598

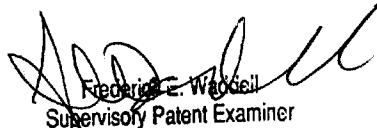
-5-

Art Unit 1205

Thus the only issue presented in the instant application is the obviousness of using the claim designated composition for an old and well known utility.

NO claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

  
Frederick E. Waddell  
Supervisory Patent Examiner  
Group 120